

App. No. : 10/056893  
Filed : 1/24/2002

### REMARKS

Applicant respectfully requests the Examiner to reexamine and reconsider this application, as amended. Claims 1-15, 17-19, 41-49 and 50-52 are currently pending in this application. Claim 1 has been amended to incorporate the essential subject matter of Claim 16. Claims 17, 18 and 19 have been amended to make them dependent on Claim 1. Claim 41 has been amended to incorporate the indicated allowable subject matter of Claim 50. Claim 50 has been cancelled and Claims 51 and 52 have been amended to depend from Claim 41. Claim 49 has been rewritten in independent form and including the limitations of indicated allowable Claim 51. Each of the Examiner's objections is addressed below:

#### **Claim Rejections - 35 U.S.C. § 103(a)**

The Examiner rejected Claims 1-13, 16, 41-46 and 49 under 35 U.S.C. § 103(a) as being unpatentable over U.S. 5,401,117 (Lochtefeld) in view of U.S. 6,019,547 (Hill). Applicant respectfully traverses these rejections and the Examiner's characterization of the cited art as applied to the amended claims.

The Examiner has the initial burden of establishing a prima facie case of obviousness under Section 103. To satisfy this burden, the Examiner must show some objective teaching in the prior art that would lead a person of ordinary skill to combine or modify the relevant teachings of the references to produce Applicant's claimed invention. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (citations omitted); see also, *In re Bell*, 991 F.2d 781, 782, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) ("A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art."). Applicant submits that no such showing can be made in this case.

Neither Lochtefeld, Hill nor any of the other cited references contain any teaching or suggestion of a surf-action game including an inclined ride surface a sheet flow of water upward onto said ride surface and one or more toy surf-action figures adapted to ride and/or perform water skimming maneuvers upon said sheet flow of water and wherein at least one of said toy surf action figures comprises a control mechanism adapted to enable a play participant to actively control the location and/or orientation of the surf action figure in relation to the injected sheet flow.

App. No. : 10/056893  
Filed : 1/24/2002

Lochtefeld discloses a full-size water surfing wave machine for generating full-scale surfing waves for use by humans. Hill discloses at column 25 that a wave forming apparatus can be reduced to a toy-sized model "for simulating surfing a child's action figure." Neither reference teaches or suggests a surf-action game in which play participants can actively control the location and/or orientation of a surf action figure in relation to the injected sheet flow so that the surf-action figure performs water skimming maneuvers upon said sheet flow of water. Thus, Applicant submits that the combination as claimed is not obvious.

The Examiner rejected Claims 10 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Lochtefeld and Hill, as applied above, and further in view of U.S. 4,963,116 (Huber). Applicant submits that the invention as a whole must be considered for purposes of determining obviousness.

The Examiner rejected Claims 14, 15, 19 47, 48 and 52 under 35 U.S.C. § 103(a) as being unpatentable over Lochtefeld and Hill, as applied above, and further in view of U.S. 5,947,788 (Darrah). Again, Applicant submits that it is the invention as a whole that must be considered for purposes of determining obviousness. Applicant further respectfully traverses the Examiner's characterization of the Darrah reference and the conclusion of obviousness. As noted above, there is nothing in Lochtefeld or Hill to suggest the claimed surf action game comprising one or more controllable surf action figures. The Examiner points to Hill for the disclosure of a controllable surfing action figure. However, Hill discloses only producing a toy-sized model wave forming apparatus for "simulating surfing a child's action figure." Hill does not disclose or suggest the desirability of a surf action game including one or more controllable surf action figures, let alone a game having one or more radio controlled surf action figures. Likewise, Darrah does not disclose or suggest the desirability of a surf action game, as recited by the Applicant's claims, using a radio-controlled surfing toy. Applicant submits that the obviousness rejection is based on conclusory reasoning as there is no teaching or motivation to combine the references as the examiner suggests.

In view of the foregoing amendments and remarks, Applicant respectfully requests that this application, as amended, is in condition for allowance and such action is earnestly requested. If the Examiner has any questions or suggestions concerning the amended claims or this response she is respectfully urged to contact the undersigned at the number indicated below.

App. No. : 10/556893  
Filed : 1/24/2002

**CONCLUSION**

This application, as amended, is believed to be in condition for allowance and such action is earnestly solicited.

Respectfully submitted,  
LAW OFFICES JONATHAN A. BARNEY

By:

Jonathan A. Barney  
Registration No. 34,292  
Customer No. 27,948

070-1106/jb